APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
ZURITA, JAMES H

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	10/082,674	OMOTO ET AL.
	Examiner	**Art Unit**	
	James H. Zurita	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 June 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*4 and 9-12*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) <u>4, 9-12</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

On 6 June 2005, applicant amended claim 4, cancelled claims 1-3, 5-8 and

added claims 9-12.

Claims 4, 9-14 are pending and will be examined.

Claim Objections

Claim 4 refers to "...the utilization charge..." that is first introduced in claim 10.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4, 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by

Ginter et al. (US 5892900).

Ginter discloses system, methods and computer-readable storage media for

monitoring the execution of software applications in a centralized electronic hub

(applicant's electronic mall). Ginter's electronic hub includes storage for software that

may be registered by a plurality of content providers (applicant's application service

providers/ASP). Ginter discloses charging users for usage of the various software

according to various schemes, including applicant's methods of recording start and end

time of utilization. Ginter discloses settling accounts, such as by paying content

providers for use of their software.

  As per claim 9, Ginter discloses an electronic mall system comprising:

(a) an ASP registration database (for example, see at least Col. 142, lines 42-64,

Col. 168, lines 1-67), for storing

- a plurality of ASPs (Col. 335, line 53-Col. 336, line 19),

- a plurality of applications provided by the plurality of application providers (for

  example, content Objects, Col. 141, lines 4-33);

- linkable applications working with the applications associated with one another

  (for example, Col. 184, line 32-Col. 185, line 152;

(b) an application search unit (for example, Col. 309, lines 38-55, see also

references to general search characteristics), operative

- to receive an application search request from a user terminal via a network (at

  least Col. 38, line 36-Col. 39, line 3, Col. 58, lines 28-49), and

- to search the ASP registration database on the basis of the received application

  search request thereby obtaining a requested application (see at least Col. 22,

  line 26-Col. 23, line 33, Col. 38, line 36-Col. 39, line 3;

(c) an application execution unit operative

- to execute the requested application if the requested application is registered in

  the ASP registration database (See, for example, at least references to real time

content and online interactive content passed to a client Col. 134, lines 39-58.

See also at least references to objects that may be only available at remote sites,

as in Col. 198, line 41-Col. 199, line 31. See also references to applications that

are executed at a server and that transmit only results to a client, such as stock

reports, Col. 308, lines 36-61) and

- to execute a linkable application if the linkable application is registered in the

  ASP registration database along with the requested application. See, for

  example, Col. 185, lines 15-53, which discloses registering a linkable application

  that is registered in the database, such as spreadsheet software program.

As per claim 4, Ginter discloses the system of claim 9 further comprising:

4.1   means for executing an application in benchmark mode. The term benchmark is

interpreted to read on guest ID, temporary ID, trial subscription. See, for example, at

least references to trial subscription, Col. 215, lines 6-42.

4.2   benchmark means for preventing the utilization charge from being levied for an

application executed for not longer than a predetermined time by the user desirous of

checking the performance of said application. See, for example, at least Col. 140, lines

10-61.

As per claim 10, Ginter discloses the system of claim 9

- wherein the ASP registration database further includes utilization charge information

  for each application (See, for example, at least Col. 154, lines 21-Col. 155, line 35),

- wherein the electronic mall system further includes settlement means (For

    settlement and distribution to content providers, please see at least Col. 316, lines 5-

    53)

    - for receiving the total amount of the application utilization charge from each

        application user, and for settling an application providing charge with each of

        the ASPs (See, for example, Fig. 4 and related text concerning different types

        of charges levied. For settlement and distribution to content providers, please

        see at least Col. 316, lines 5-53),

the total amount of the application utilization charge for each user calculated based

    - on utilization charge information stored in the ASP registration database (See,

        for example, at least Col. 154, lines 21-Col. 155, line 35) and

    - on information of a utilization start time and a utilization end time of the

        application as logged by the application execution unit when the application is

        executed (See, fore example, at least Col. 154, lines 21-Col. 155, line 35),

the application providing charge being calculated based on a measure of application

utilization for each of the ASPs (See, fore example, at least Col. 154, lines 21-Col. 155,

line 35).

As per claim 11, Ginter discloses methods for executing applications including:

(a)   receiving an application search request from a user terminal via a network (to

receive an application search request from a user terminal via a network (at least Col.

38, line 36-Col. 39, line 3, Col. 58, lines 28-49), and

(b)   searching an ASP registration database on the basis on the received application

search request, the ASP registration database including [a plurality of ASPs, a plurality

of applications provided by the plurality of application providers, and linkable

applications working with the applications associated with one another] (see at least

Col. 22, line 26-Col. 23, line 33, Col. 38, line 36-Col. 39, line 3);

(c)   executing a requested application if the requested application is registered in the

ASP registration database as determined in the searching step (See, for example, at

least references to real time content and online interactive content passed to a client

Col. 134, lines 39-58. See also at least references to objects that may be only available

at remote sites, as in Col. 198, line 41-Col. 199, line 31. See also references to

applications that are executed at a server and that transmit only results to a client, such

as stock reports, Col. 308, lines 36-61); and

(d)   executing a linkable application if the linkable application is registered in the ASP

registration database along with the requested application (See, for example, Col. 185,

lines 15-53, which discloses registering a linkable application that is registered in the

database, such as spreadsheet software program).

As per claim 12, this claim is rejected on the same reasons set forth in Claim 11.

Response to Arguments

Applicant's arguments filed 6 June 2005 have been fully considered.

Objections to the drawings are withdrawn in view of amendment.

Objections to claims 1-3, 5-8 are moot in view of cancellation of those claims.

The Examiner acknowledges that claim 4 seeks to invoke the sixth paragraph of

35 USC 112.

Applicant's remaining arguments concerning 35 USC 102(e) rejection have been

very carefully and thoroughly considered but are not persuasive. Applicant argues that

several features are absent in Ginter:

> [Ginter's] information utility does not show the application *search* function either.
>
> Further, the present invention stores the linkable application 204 in the application service provider registration database 105 (page 9, lines 25 to 29 of the pending specification). The electronic mall system can *execute* such linkable applications with the application that is requested by the user (page 6, lines 1-4 of the pending specification).
>
> Accordingly, the present invention is different from Ginter in that the
> [a]   *application search function*,
> [b]   application *execut*ion function, and
> [c]   linkable application registration & *execut*ion functions
> are not shown [in Ginter, emphasis and punctuation added]

Application Search functions

In response to applicant's arguments that Ginter does not disclose search

functions, the Examiner respectfully directs applicant's attention to at least col. 22, line

26-col. 23, line 30, concerning artificial intelligence search tools, search criteria for user

selection. See also Col. 38, line 36-Col. 39, line 3, concerning user specified searches.

Please see also Col. 110, lines 17-50, concerning browsing and searching information

such as content, abstracts and commentary.

Application Execution functions

Applicant appears to argue that his invention is directed to executing an

application at a server and transmitting only results to a client. Applicant appears to

interpret Ginter as requiring downloading executable code to a client in order to present

results (i.e., output) at a client:

...the electronic mall system stores various applications provided by ASPs and executes the applications in response to the user request. However, the electronic mall system does not distribute the application itself. Instead, it receives the request from the user, executes the application while logging the application utilization information, and transmits the execution results to the user. [Page 9, lines 3-6].

First, the Examiner notes that the features upon which applicant relies are not recited in the rejected claim(s). The claims specifically avoid reciting *where* (client or server) execution takes place. For example, method claim 11 reads:

(New): A method for *executing* applications of an electronic mall, comprising steps of:
(a)   receiving an application search request from a user terminal via a network;
(b)   searching an application service provider registration database on the basis on the received application search request, the application service provider registration database including
   •   a plurality of application service providers [sic],
   •   a plurality of applications provided by the plurality of application providers, and
   •   linkable applications working with the applications associated with one another;
(c)   executing a requested application if the requested application is registered in the application service provider registration database as determined in the searching step; and
(d)   executing a linkable application if the linkable application is registered in the application service provider registration database along with the requested application.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, Applicant appears to argue that Ginter does not disclose executing applications at a server and sending results to a client:

...Ginter... the electronic contents and distributes them to the consumer with additional information, such as "rules & controls" (Fig. 2). However, the information utility does not execute the electronic contents... [page 9, lines 6-10]

The Examiner respectfully disagrees with applicant's interpretation of Ginter and respectfully directs applicant's attention to several portions of Ginter that discloses that applications may be executed at a remote node and results may be transmitted to a client. See, for example, at least references to real time content and online interactive

content passed to a client Col. 134, lines 39-58. See also at least references to objects

that may be only available at remote sites, as in Col. 198, line 41-Col. 199, line 31. See

also references to applications that are executed at a server and that transmit only

results to a client, such as stock reports, Col. 308, lines 36-61.

Linkable application registration & execution functions

In response to applicant's arguments that Ginter does not disclose linkable

application registration and execution functions, the Examiner respectfully directs

applicant's attention to at least Fig. 43b, particularly Col. 185, lines 15-53, which

discloses registering a spreadsheet software program, as described in applicant's Fig.

2, item 204, EXCEL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 3625
30 August 2005

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